

### REMARKS

Claim 7 and 26-34 are pending in the present application. Claim 7 is amended herein to convert a product-by-process limitation into an explicit step. Support for new claim 26 can be found in claim 8 as previously presented as well as in the present specification, *inter alia*, at the paragraph bridging pages 55 and 56. Support for new claims 27-29 can be found in claims 12-14, respectively, as previously presented. Support for new claim 30 can be found in claims 7 and 22 as previously presented. Support for new claims 31-32 can be found in claims 24-25, respectively, as previously presented. Support for new claims 33-34 can be found in the present specification, *inter alia*, at the paragraph bridging pages 55 and 56. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claim.

### Issues under 35 U.S.C. § 103(a)

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schauder et al. '766 (US 5,728,766) in view of Singha et al. (Journal of Applied Polymer Science) (pages 2-6 of the outstanding Office Action and page 2 of the Advisory Action).

Applicants respectfully traverse. Reconsideration and withdrawal of this rejection are respectfully requested.

### Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

*Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

#### Distinctions over the Cited References

Independent claim 7 recites the step of “hydrogenating natural polyisoprenoid in the state of latex...to obtain a hydrogenated natural polyisoprenoid” (emphasis added). As the Examiner admits, the cited references fail to disclose this element.

However, the Examiner asserts that this claim is a product-by-process claim (page 4, first full paragraph of the outstanding Office Action). In the Advisory Action dated March 23, 2011, the Examiner states, “Although the claim as a whole is a method claim, the limitations with regard to the process of making the starting material is written in a product by process format.... Absent an explicit step of preparing the polymer in the claimed method, the limitations on its production are being treated as a product by process limitation.”

In response, claim 7 is amended herein to recite the step of preparing the polymer explicitly. As such, the step of “hydrogenating natural polyisoprenoid in the state of latex...to obtain a hydrogenated natural polyisoprenoid” should be fully considered.

Schauder et al. ‘766 teach a rubber-like article comprising an ethylene-propylene copolymer that has been molded and vulcanized. Schauder et al. ‘766 teach that the copolymer has a molecular weight distribution between 1 and 8. However, Schauder et al. ‘766 fail to teach the step of subjecting a rubber composition comprising a hydrogenated natural polyisoprenoid to molding/forming accompanied by vulcanization. Furthermore, Schauder et al. ‘766 do not teach the step of “hydrogenating natural polyisoprenoid in the state of latex...to obtain a hydrogenated natural polyisoprenoid.”

Singha et al. teach hydrogenating a natural rubber/*Hevea brasiliensis* to a degree of hydrogenation of 100% in the presence of a rhodium complex in a solvent. However, Singha et al. do not teach the claimed process step comprising a hydrogenated natural polyisoprenoid. Furthermore, Singha et al. do not teach the step of “hydrogenating natural polyisoprenoid in the state of latex...to obtain a hydrogenated natural polyisoprenoid” (emphasis added).

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Schauder et al. '766 in view of Singha et al. fail to disclose all of the claim limitations of independent claim 7. Accordingly, the combination of references does not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

#### **New Claims 26-34**

Claims 26-34 have been added for the Examiner's consideration. As discussed above, the cited references fail to disclose the step of "hydrogenating natural polyisoprenoid in the state of latex...to obtain a hydrogenated natural polyisoprenoid" as recited in independent claim 7. Independent claims 26 and 30 contain a similar limitation. Specifically, claim 26 recites that "said hydrogenated natural polyisoprenoid is an ingredient in modified lattices obtained by hydrogenating natural polyisoprenoid in the state of latex," and claim 30 recites the step of "hydrogenating natural polyisoprenoid in the state of latex...to obtain a hydrogenated natural polyisoprenoid." Claims 27-29 depend from claim 26. Claims 31-32 and 34 depend from claim 30. Claim 33 depends from claim 7. For the reasons given above, new claims 26-34 are allowable.

#### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. A complete response has been made to the outstanding Office Action, and as such, the application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Registration No. 58,258, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: JUN 14 2011

Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

703-205-8000